

REMARKS

The issues outstanding in the Office Action mailed November 20, 2003, are the rejections under 35 U.S.C §112 and 103. Reconsideration of these rejections, in view of the following discussion, is respectfully requested.

Rejection Under 35 U.S.C §112

Claims 4-9 and 12-15 have been rejected under 35 U.S.C §112, second paragraph. Reconsideration of this rejection is respectful requested.

A minor change to claims 4 and 15 has been made, as supported at page 7, table 1, the paragraph bridging pages 7 and 8, and the last paragraph at page 8. It is submitted that this clarifying amendment does not change the scope of the claim, either literally or for purposes of the doctrine of equivalents, inasmuch as the change merely makes explicit what was clearly implicit in the claims previously. Withdrawal of the rejection is again respectfully requested.

Rejection Under 35 U.S.C §103

Claims 4-9 and 12-15 remain rejected under 35 U.S.C §103 over Flescher '024 or Werenicz '887 or WO '174, each in view of Tesch '327. Reconsideration of this rejection is again respectfully requested.

As will be recalled, each of the three primary references discloses films which are water vapor permeable. In particular, Flesher discloses a polyetheresteramide, and water vapor permeable films thereof. Patentees teach that these films are used in "many application[sic] and especially for composite articles and objects provided with such film(s) and intended for contact with the human or animal body." Patentees list, in particular, manufacture of clothing, footwear, adhesive or non-adhesive dressings, or compresses and linen employed in operating units, as well as hardware supports for curative or preventative medications administered subcutaneously. Patentees further indicate that the films may be used in the manufacturing of seats such as motor vehicle seats or under roofing materials in order to increase leak proofing of the roof without retaining moisture. See column 3, lines 20-60.

Werenicz discloses a polyurethane-based film, which is water permeable, and teaches that the film may be used in "applications in which water-vapor permeability is desirable." See column 1, lines 23-26. Patentees teach that these applications include weatherproof clothing and tarpaulins, and "in the construction industry." See column 1, lines 21-24.

WO 96/15174 discloses polyethers used in biodegradable moldings, adhesives, foams and blends with starch. See the abstract.

Thus, as admitted in the Final Rejection, these references fail to suggest the use of their films in the production of covers for composting. In order to remedy this deficiency, the office action relies upon Tesch. However, the films disclosed in therein have significant differences from those of the primary references. While the Final Rejection argues that "Tesch advises, but does not necessarily require, that slits within the film be used to control [oxygen or air permeability]," in fact, patentees clearly teach that slitting of the film is *necessary* where gas permeability is desired. For example, patentees teach that it is "desirable, if not necessary, to appropriately slit the web *to allow appropriate transfer of gases*." See col. 4, lines 58-62. Patentees teach that air permeability "is provided in the polymeric sheet by a precisely controlled slitting operation or in the fiber sheet by control of, for example, the degree of compression during fabrication." See col. 3, lines 65-end. This "fiber sheet" is the embodiment which may not be slitted according to patentees, although patentees teach that slitting may be performed on the fiber sheet to *increase* permeability. See col. 6, lines 65-66. The fiber sheet, which is spun-fleece, etc., see col. 6, line 50, is not equivalent to the materials of the primary reference or the present claims, which are polymeric in nature, and it appears that permeability is introduced into the fiber by producing an open weave by controlling the degree of compression, see col. 3, lines 65-end. Thus, patentees clearly teach that, *for polymeric webs*, slitting is necessary to control moisture. Thus, at best, this combination of references would teach slitting of the films of the primary references, in order to increase gas permeability. However, of course, such slits would render the films permeable to liquid water, and thus the combination of the reference would not result in the presently claimed materials. While it is argued, at page 3 of the Final Rejection, that one of ordinary skill "would have fully realized that the film permeability's of Tesch can be achieved by the

use of the permeable films taught by the primary references, without the need for slitting the films," it is submitted this is, at best, hindsight reconstruction, inasmuch as Tesch teaches that slitting of the films is desirable, *if not necessary*, to achieve appropriate permeability. Thus, the Office Action fails to provide a reason why one of ordinary skill in the art would have motivation to address the very problem of the secondary reference, permeability, by using a film which *lacks* the solution of the secondary reference, the slits. Such a modification is only obvious where the artisan is benefited with the hindsight of the present application, desiring to increase gas permeability while restricting liquid permeability. This motivation is not provided from the combination of the references.

Moreover, it is maintained that Tesch and the remaining references are directed to nonanalogous art areas, and would not be combined by one of ordinary skill in the art. As discussed in the prior response, the test for non-analogous art is set forth in *In re Clay*, 966 F.2d 656, 23 USPQ2d, 1058 (Fed. Cir. 1992), where the Federal Circuit indicated that there is a two step test to determine whether references are combinable. First, one must inquire whether the references are in the same field of endeavor. It is clear that, in the present situation, they are not. As noted above, the primary references disclose clothing, foot wear, adhesive dressing, motor vehicle seats, roofing materials, weather proof clothing, tarplins in the construction industry, biodegradable molding and adhesives, etc. Thus, the primary references are not directed to the specific needs of composting, unlike the secondary reference. It is noted that the mere fact that the primary references are arguably directed to polymeric sheets in which water permeability might be a "concern," is insufficient to place the references in the category of analogous art. For example, in *Clay, supra*, the Federal Circuit found that injecting gel into an oil tank to remove dead space was *not* equivalent to injecting gel into a subterranean reservoir to flush out oil, although it clearly could have been argued (and was, by the PTO), that both references were directed to injecting gel into a space to flush out oil. However, the Federal Circuit found that different concerns would be encountered by artisans in both areas and, thus, the art was not analogous. The same is the situation here, where the primary reference is not concerned with the exacting permeability needs of composting, and the secondary reference is unconcerned with the specific permeability needs of shoes and roofing, etc.

The second portion of the Clay test is whether the references are "reasonably pertinent to the same problem." As can be seen from the above discussion, they are not, in view of the differing concerns in composting versus the other applications enumerated above. Thus, it is submitted that the references are in non-analogous areas, and would not be combined by one of ordinary skill in the art.


Thus, while it is argued at page 4 of the Final Rejection that the primary and secondary references are analogous in that they are "concerned with the utilization of polymeric materials having gas permeabilities that are suitable for protection from the elements", it is clear that the test set forth in Clay is far more strict than this. Indeed, in *Clay, supra* both references flushed in gel to remove oil. However, the Federal Circuit found that different concerns would be encountered by artisans in both areas. In the present situation, the factors determining whether a compost heap "breathes" successfully are clearly not the same as breathability in clothing, footwear, adhesive dressings or compresses employed in operating units, much less seats for motor vehicles. Thus, Applicants maintain that their argument concerning the non-analogous nature of these references.

According, it is respectfully submitted that the combination of references does not render the present claims obvious under 35 U.S.C §103, and withdrawal of the rejection is again respectfully requested.

Should the Examiner have any questions or comments, he is cordially invited to telephone the undersigned at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Harry B. Shubin (Reg. No. 32,004)
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

FILED: February 19, 2004

HBS/jqs
K:\Atocm\100-199\163\Reply 2-17-04.doc